



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No.: 09/602,923
Filing Date: June 23, 2000
Appellant: Bernard Duroux et al.
Group Art Unit: 2872
Examiner: Ricky D. Shafer
Title: EXTERIOR MIRROR FOR MOTOR VEHICLE
Attorney Docket: SCH-00039

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P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is a Reply Brief in response to the Examiner's Answer mailed November 4, 2003. The Reply Brief is submitted in triplicate.

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Response Arguments

A. Scope of Claim 1

In the Examiner's Answer it was argued that the Appellant was arguing beyond the scope of claim 1. More specifically, the Examiner argued that the statements in the Appellant's Appeal Brief indicating that Tomiyoshi and Schenk et al. were different from claim 1 because they fail to teach or suggest "swing speeds" that indicate more than one speed being possible at a given time. The Examiner professed that this was a feature not present in Appellant's claims. See Appellant's Appeal Brief, p.6, and Examiner's Answer, p.8. Appellant respectfully disagrees with the Examiner's position that claim 1 does not claim more than one speed being possible at any given time. To the contrary, the Appellant asserts that while the language of claim 1 does not explicitly state more than one speed at any given time, however, it does say that there is "a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at the first speed or at the second speed..." [emphasis added] It is not necessary to add the limitation of "at any given time" since the word "or" as used in the claim clearly already conveys that a first or second speed is available at any given time. Furthermore, the specification is very clear that there is a controller that allows the motor to "selectively drive the housing about the first axis either at a first speed or at a second speed which is faster than the first speed." Appellant's application, p.2. Later, the specification defines the two speeds in more detail. During a mirror adjustment operation when the mirror housing is adjusted up, down, left or right, the mirror housing is moved at a rate of about 3° per second. If the operator of the vehicle selects to move the mirror housing to a "park" mode, the mirror housing will be moved into position at a rate of 30° per second. See Appellant's application, p.4. At any given time the mirror housing can selectively move about a first axis at a first or second discrete speed.

B. The Scope of the Prior Art

Appellant pointed out in their Appeal Brief that Tomiyoshi and Schenk et al. do not adequately fill the void left by Enomoto et al. or Valentino. That is, both of the references fail to disclose that “the controller is adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and a second discrete speed.” Appellant still maintains that Tomiyoshi and Schenk et al. do not cure these deficiencies, nor has the Examiner in his Answer explained how Tomiyoshi or Schenk et al. adequately fulfill the void left by Enomoto et al. or Valentino.

Tomiyoshi discloses that the swing speed of the motor-driven mirror can be adjusted. There is nothing that teaches or suggests the “swing speed” being selectable at more than one speed at a given time. Tomiyoshi only mentions that the rotating speed of the motors (not the mirror) can be adjusted. Thus, one of ordinary skill in the art would interpret that to mean that the motors, and thus the mirror, can be adjusted to rotate either slowly or rapidly or somewhere in between based on predetermined settings, but that does not mean that both slowly and rapidly at a given time, as the instantly claimed invention recites. In other words, the mirror taught by Tomiyoshi will rotate slowly or quickly, but not selectively both.

Schenk et al. does not suggest a two-speed mirror adjustment system, wherein both speeds are determined by the movement of an output shaft of a motor. For example, Schenk et al. teaches away from using a two-speed mirror adjustment system that is controlled strictly by the movement of the output shaft of the motor. Instead, Schenk et al. teaches using a “slow actuator 11” that is used for normal folding in and folding out of the side view mirror housing 1. See col. 3, lines 57-61. In order to achieve a second speed, Schenk teaches away from having the motor shaft being driven at two distinct speeds when it teaches the use of a “rapid actuator 12” that is “...reinforced by the force of a pre-stressed spring element, which is parallel to the slow actuator and receives an actuating signal from control device 7.” Col. 3, lines 61-64. The use of a “rapid actuator 12” in the form of a pre-stressed spring element in addition to a “slow actuator

11," such as a motor, teaches away from having a motor that has an output shaft that moves at a first discrete speed or a second discrete speed. Thus, one of ordinary skill in the art would not be inclined to modify Schenk et al. so that the motor would have an output shaft that rotates at a first discrete speed or a second discrete speed at any given time. Schenk teaches using two separate actuator mechanisms for rotating the mirror housing at two different speeds.

C. There is No Motivation to Combine the References

Regarding the motivation to combine the references, the Examiner has asserted that the motivation is not rooted in the references themselves, but rather the motivation exists **in the knowledge generally available to one of ordinary skill**. See Examiner's Answer, citing *In re Fine*, 837 F.2d 1071, 5, U.S.P.Q. 2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992). While this is one way of establishing motivation to combine the references, the Examiner must "...explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [Rouffet's] invention to make the combination..." See *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991). The Examiner's Answer stated:

Tomiyoshi and Schenk et al. each clearly teach a controller (i.e., circuit (10) with adjusting means (27) shown in Figures 6 and 9, of Tomiyoshi and control device (7) with actuating mechanism (2), shown in Figures 1 and 2 of Schenk et al.) to selectively control the rotational speed of an electric motor of a door mirror and/or swing (folding) speed of a side view mirror housing, respectively, which would obviously convey to one of ordinary skill in the mirror art the general knowledge of a door mirror assembly having a controllable swing speed adjustment to avoid impact or collision with an object or body which may damage the mirror assembly. See Examiner's Answer, pp.5-6.

The Examiner argued that the features of Tomiyoshi and Schenk et al. make it obvious for one of ordinary skill in the art at the time the invention was made to modify the controllers in Enomoto et al. or Valentino to include a "controllable

swing speed adjustment in order to avoid impact or collision with an object or body which may damage the door assembly.” See Examiner’s Answer, p.6.

Appellant asserts that the Examiner’s supporting arguments for motivation to combine the subject references is improper. In pertinent part, claim 1 of the appealed claims states:

...an electric motor having an output shaft selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at a first speed or a second speed which is faster than the first speed.

Nothing in the Examiner’s rational suggests that a person having knowledge generally available to one of ordinary skill in the art would combine Tomiyoshi or Schenk et al. with either one of Enomoto et al. or Valentino in order to have a motor with a first discrete speed and a second discrete speed as outlined in claim 1 above. Instead, the Examiner’s Answer states “[t]hus, it certainly would have been obvious and/or within the level of ordinary skill in the art at the time the invention was made to modify the controller or Enomoto et al. or Valentino to include a **controllable swing speed adjustment** in order to avoid impact or collision with an object or body which may damage the door mirror assembly.” See Examiner’s Answer, p.6 (emphasis added). Therefore, the Examiner has failed to set forth the proper motivation since there is no motivation to combine the references to make the combination proposed in claim 1.

In summary, the Appellant points out that the Examiner’s reliance upon the Tomiyoshi and Schenk et al. references does not fill the void left by Enomoto et al. or Valentino. That is, the primary references fail to teach or suggest an electric motor selectively configured to “selectively drive the housing about the first axis either at a first speed or a second speed which is faster than the first speed.” See claim 1. The secondary references (i.e., Tomiyoshi and Schenk et al.) fail to teach or suggest this limitation. Instead, the Tomiyoshi and Schenk et al. references were relied on to teach or suggest a “controllable swing speed adjustment.” See Examiner’s Answer, p.6. The Examiner’s explanation for

combining the references is improper since it fails to explain a specific understanding or principle that would motivate one skilled in the art to make the combination of the invention described in claim 1 of the present application.

D. Failure of the References to Render Claim 1 Obvious

The Examiner also stated that the test for obviousness did not involve an assessment of whether the features of the secondary reference may be bodily incorporated into the structure of the primary reference, but rather the test is whether the combined teaching of the references, as a whole, would have been obvious to those of ordinary skill in the art. However, this principle does not relieve the burden of showing that the references render the entire claim obvious. A single reference or combination of references must still show all of the elements and their arrangement in order for an obviousness rejection to be valid. *PIN/NIP, Inc. v. Platte Chemical Co.*, 304 F.3d 1235, 64 U.S.P.Q. 2d 1344 (Fed. Cir. 2002).

The Examiner's combination of references fails to disclose all of the elements of claim 1. Namely, the references fail to disclose the portions of claim 1 that define a first discrete speed or a second discrete speed which is faster than the first discrete speed. This limitation was admitted by the Examiner as not being present in the Enomoto et al. or Valentino references. See Examiner's Answer, pp.3-4. However, the Examiner relied upon Tomiyoshi or Schenk et al. for the stated purpose of making it

"...obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the controller of Enomoto et al. or Valentino to include a controllable swing speed adjustment in order to avoid impact or collision with an object or body which may damage the door mirror assembly." See Examiner's Answer, p.6.

This clearly does not fulfill the void left by Enomoto et al. or Valentino. That is, Tomiyoshi and Schenk et al. were relied on for providing **a controllable swing speed adjustment** and **NOT a motor having an output shaft that operates at a first discrete speed and a second discrete speed**. The only way Tomiyoshi

or Valentino would operate at two speeds would be to make an adjustment from a first speed to a second speed. Both Tomiyoshi and Schenk et al. do not teach having a first discrete speed or a second discrete speed, rather, they teach having one speed that is adjustable. For this reason, the Examiner's obviousness argument with respect to claim 1 will fail since all of the references taken as a whole fail to teach or suggest each and every element of claim 1. The fact that Tomiyoshi or Schenk et al. only teach a means for adjusting the motor speed does not render claim 1 obvious since adjusting the motor speed is not the same as having a motor with a first discrete speed or a second discrete speed which is faster than the first discrete speed.

E. Impermissible Hindsight

It is firmly established that when the incentive to combine the references is not apparent from the references themselves, and the Examiner has not explained why the combination of the reference teachings is proper, then the teachings of the references are not combinable. *Ex parte Skinner*, 2 U.S.P.Q. 2d, 1788, 1790 (BPAI 1987). In the present appeal, the Examiner has not explained why the teachings of the references are combinable to **render the claimed invention obvious**. It has been held that failure of the Examiner to provide the necessary suggestion or motivation creates a presumption that the combination of references selected by the Examiner to support the obviousness rejection were based on hindsight. *In re Rouffet*, 149 F.2d 1350, 47 U.S.P.Q. 2d 1453, 1458 (Fed. Cir. 1998). Appellant asserts that Examiner's obviousness rejection was improperly based upon hindsight since it is clear that the Examiner's argument provides no specific understanding or principle that would motivate one of ordinary skill in the art to combine the Tomiyoshi or Schenk et al. references with either one of Enomoto et al. or Valentino. Clearly Tomiyoshi and Schenk et al. were selected because of their results, that is, the fact that these patents disclose adjustable motor speed or a spring loaded "rapid actuator." Appellant maintains that these references not only fail to render each and every element of claim 1 obvious, but also they lack suggestion or motivation to be

combined with the primary references of Enomoto et al. or Valentino. Therefore, the Examiner's impermissible use of hindsight clearly defeats any obviousness rejection with respect to the present application.

Conclusion

In summary, Appellant stresses that the Examiner's argument for obviousness fails to teach or suggest all of the elements of claim 1. More specifically, the portion of claim 1 defining a first discrete speed or a second discrete speed has not been rendered obvious. The primary references relied on for the obviousness argument were Enomoto et al. and Valentino. However, the Examiner admitted that these references failed to render obvious the electric motor shaft operating at a first discrete speed or a second discrete speed. See Examiner's Answer, p.4. As discussed above, the secondary reference (i.e., Tomiyoshi and Schenk et al.) failed to fill the void left by the primary references. The Examiner relied on these references for the purpose of teaching that it "is known to adjust the swing speed of a mirror assembly in the same field of endeavor for the purpose of regulating the operating speed of the mirror assembly." See Examiner's Answer, p.4.

Claims 2-7 are all ultimately dependent upon claim 1, therefore, they will also not be rendered obvious by virtue of their dependency. Likewise, the Examiner's Answer acknowledges that claims 2-7 will stand or fall with claim 1. Therefore, further analysis with respect to these claims is not necessary at this time.


Please send all future correspondence relating to this application to Warn, Burgess & Hoffmann, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

P.O. Box 70098
Rochester Hills, MI 48307
(248) 364-4300

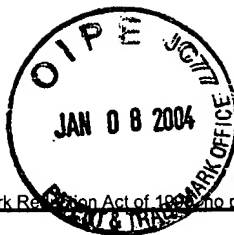
WARN, BURGESS & HOFFMANN, P.C.
Attorneys for Appellant(s)

Dated: January 5, 2004

By: 
Philip R. Warn
Reg. No. 32775

PRW:GLO:acw

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